

Remarks

Claim 7 is cancelled.

Claims 1, 8, 9 and 22 are amended.

Claim 24 is added. Support for claim 24 can be found in claim 1 as originally filed and previously amended. Applicant reserves the right to introduce claims dependent on new claim 24 that are similar in scope to claims 8-12, 14-16 and 22-23.

Applicant reserves the right to pursue the subject matter of the originally filed claims in a continuing application.

No new matter has been added.

Election of Species

In requiring the election of species, the Examiner explicitly required the election of a species “for prosecution on the merits and to which the claims shall be restricted if no generic claim is finally held to be allowable.” At that time, the Examiner stated that claims 1, 7, 8 and 12-18 were generic. In response, Applicant elected the species of $-B(D_1)(D_2)$ compounds of claims 7 and 17. At that time, Applicant re-iterated for the record that the election was made for examination purposes only and that the claims would be restricted to this species only if no generic claim is *finally* held to be allowable. Accordingly, the Examiner’s statements in the present and earlier office action are confusing. For example, the Examiner states in the present office action that claims 22 and 23 are withdrawn from further consideration as being drawn to a non-elected species, “there being no allowable generic or linking claim”.

Claim 1 is now amended to introduce the limitations of claim 7 (now cancelled). Claim 1 as now amended is still a generic claim with respect to the T groups recited therein and encompasses species (e) through (i) of the election. Accordingly, claims 22 and 23 should not be withdrawn from consideration as they fall within the scope of claim 1. Applicant respectfully requests that the Examiner reconsider and reinstate claims 22 and 23.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 8 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Claim 8 has been amended to delete reference to the R groups of proline or alanine. Accordingly, the rejection should be moot.

Non-Statutory Double Patenting Rejection
under Judicially Created Doctrine of Obviousness-Type Double Patenting

Co-Pending Application 09/578,363:

Claims 1, 7-10, 12 and 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 11-19, 31 and 36-81 of copending application no. 09/578,363 because, according to the Examiner, a colorectal cancer (as disclosed in 09/578,363) is an intestinal disease.

Applicant has amended claim 1 to delete reference to intestinal disease. Applicant has added new claim 24 which recites intestinal disease that is not a cancer, neoplasm or tumor. Support for this amendment can be found in the originally filed claims and the intervening claim amendments which deleted reference to cancer, neoplasm and tumor. Accordingly, these latter medical conditions were not within the scope of the claims prior to the instant amendment. For the sake of clarity, Applicant has explicitly excluded these conditions from new claim 24. While Applicant does not concede the propriety of the Examiner's comments regarding claims 14-16, they do not address the rejection now in view of the amendment of the claims and the statements made above.

Claim 11 is rejected on the same basis in view of the above-noted application and Snow. The rejection of claim 11 is moot as a result of the amendment to claim 1 (and the scope of new claim 24).

The Examiner is respectfully requested to reconsider and withdraw the rejection.

Co-Pending Application 10/384,121:

Claims 1, 7-10, 12 and 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13, 15-29, 32-35 and 38-55 of copending application no. 10/384,121 because, according to the Examiner, a colorectal cancer (as disclosed in 10/384,121) is an intestinal disease.

Applicant has amended claim 1 to delete reference to intestinal disease. Applicant has added new claim 24 which recites intestinal disease that is not a cancer, neoplasm or tumor. Support for this amendment can be found in the originally filed claims and the intervening claim amendments which deleted reference to cancer, neoplasm and tumor. Accordingly, these latter medical conditions were not within the scope of the claims prior to the instant amendment. For the sake of clarity, Applicant has explicitly excluded these conditions from new claim 24. While Applicant does not concede the propriety of the Examiner's comments regarding claims 14-16, they do not address the rejection now in view of the amendment of the claims and the statements made above.

Claim 11 is rejected on the same basis in view of the above-noted application and Snow. The rejection of claim 11 is moot as a result of the amendment to claim 1 (and the scope of new claim 24).

The Examiner is respectfully requested to reconsider and withdraw the rejection.

Rejections under 35 U.S.C. §102

U.S. Patent Application Publication No. 2003/0158114:

Claims 7 and 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wallner et al. 2003/0158114 because, according to the Examiner, colorectal cancer (as recited in 2003/0158114) is an intestinal disease.

Claim 1 does not recite intestinal disease. Accordingly, claims 7 and 8 are not anticipated by 2003/0158114. Additionally for the record, new claim 24 recites an intestinal disease that is not a cancer, tumor or neoplasm.

The Examiner is respectfully requested to reconsider and withdraw the rejection.

WO 98/25644:

Claims 1, 9, 12 and 15 are rejected under 35 U.S.C. § 102(a) and claims 7 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 98/25644. According to the Examiner, WO 98/25644 teaches co-administration of GLP-2 and DPP-IV inhibitors to treat or prevent gastrointestinal disorders.

Claim 1 has been amended to delete reference to intestinal disease. Accordingly, claims 1, 9, 12 and 15 are not anticipated by WO 98/25644.

New claim 24 recites a method that *consists essentially of* administering a DPP-IV inhibitor to a subject for treating an intestinal disease. WO 98/25644 explicitly teaches GLP-2 as the primary therapeutic agent. All other agents, including DPP-IV inhibitors, are *co-administered* with GLP-2. New claim 24 is therefore not anticipated by WO 98/25644.

The Examiner is respectfully requested to reconsider and withdraw the rejection.

WO 98/25644 in view of Snow:

Claim 11 is rejected under 35 U.S.C. § 102(a) as being anticipated by WO 98/25644 in view of Snow. According to the Examiner, WO 98/25644 teaches co-administration of GLP-2 and DPP-IV inhibitors to treat or prevent gastrointestinal disorders and Snow teaches that boronic acid dipeptides are in equilibrium with their cyclized form.

Claim 1 and new claim 24 are not anticipated by WO 98/25644, as discussed above. Snow does not add to the teachings of WO 98/25644. Accordingly, claim 11 is not anticipated by WO 98/25644 in view of Snow.

The Examiner is respectfully requested to reconsider and withdraw the rejection.

Rejection under 35 U.S.C. §103

WO 98/25644 in view of Snow:

Claim 10 is rejected under 35 U.S.C. § 103(a) as being obvious in view of WO 98/25644 and Snow.

WO 98/25644 does not teach treatment of arteriolosclerosis or insufficient blood clotting using a DPP-IV inhibitor. WO 98/25644 also does not teach a method of treating an intestinal disease consisting essentially of administering a DPP-IV inhibitor to a subject in need thereof. Snow does not provide the deficiencies in WO 98/25644. Accordingly, the combination of WO 98/25644 and Snow does not render obvious claim 10.

The Examiner is respectfully requested to reconsider and withdraw the rejection.

WO 98/25644 in view of WO 93/08259:

Claim 14 is rejected under 35 U.S.C. § 103(a) as being obvious in view of WO 98/25644 and WO 93/08259.

WO 98/25644 does not teach treatment of arteriolosclerosis or insufficient blood clotting using a DPP-IV inhibitor. WO 98/25644 also does not teach a method of treating an intestinal disease consisting essentially of administering a DPP-IV inhibitor to a subject in need thereof. WO 93/08259 does not provide the deficiencies in WO 98/25644. Accordingly, the combination of WO 98/25644 and WO 93/08259 does not render obvious claim 14.

The Examiner is respectfully requested to reconsider and withdraw the rejection.

WO 98/25644:

Claim 16 is rejected under 35 U.S.C. § 103(a) as being obvious in view of WO 98/25644.

WO 98/25644 does not teach treatment of arteriolosclerosis or insufficient blood clotting using a DPP-IV inhibitor. WO 98/25644 also does not teach a method of treating an intestinal disease consisting essentially of administering a DPP-IV inhibitor to a subject in need thereof. Accordingly, WO 98/25644 does not render obvious claim 16.

The Examiner is respectfully requested to reconsider and withdraw the rejection.

Summary

Applicant believes that each of the pending claims is in condition for allowance. If the Examiner has any questions and believes that a telephone conference with Applicant's representative would prove helpful in expediting the prosecution of this application, the Examiner is urged to call the undersigned at (617) 646-8266.

Respectfully submitted,
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